

Serial No. 08/963,096
Group Art Unit: 1649

REMARKS

Reconsideration of the present application is respectfully requested. Claims 82 and 83 have been canceled without prejudice in order to expedite prosecution.

Applicant reserves the right to present the canceled claims in a continuing application.

Claims 72-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner objects to the term "characterized".

The term has been deleted from claims 74, 77, 79 and 84 as suggested by the Examiner.

Claims 79-81 are rejected under 35 U.S.C. 112, second paragraph.

The Examiner states that "elite" is operationally defined and is indefinite.

The phrase containing elite in claim 79 has been deleted, therefore overcoming the rejection.

Claims 82-83 are rejected under 35 U.S.C. 112, second paragraph.

These claims have been canceled in order to expedite prosecution and therefore the rejection is moot.

Claims 74-76 and 79-81 are rejected under 35 U.S.C. 102(e) as being anticipated by Hiei *et al.* US Patent No. 5,591,616 .

Amended claim 74 and 79 distinguish over Hiei *et al.* by reciting "a maize plant stably transformed". Hiei *et al.* disclose *GUS* expressing calli. However, this alone is not conclusive evidence of stable transformation in calli, let alone in plants. Hiei *et al.* do not disclose plants that expressed *GUS*, see Table 10 and Col. 19, line 26. Therefore, the '616 patent does not anticipate or make obvious a maize plant stably transformed.

Claims 74-86 and 88-89 are rejected under 35 U.S.C. 102(e) as being anticipated by or in the alternative under 35 U.S.C. 103 as obvious over Lundquist *et al.*, US Patent No. 5,484,956.

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As indicated by the Examiner the claims distinguish over the '956 patent by requiring the plant is transformed with *Agrobacterium*.

As noted above claims 82-83 have been canceled. Claims 88-89 depend from an allowed claim and therefore are deemed patentable.

A 1.132 Declaration is submitted that provides data indicating that *Agrobacterium*-mediated transformation produces a different and superior product. For example a very high proportion of single-copy (or low copy) integration events are obtained with *Agrobacterium*-mediated transformation. By contrast bombardment transformation produces a product with much higher transgene copy numbers.

Further *Agrobacterium*-mediated transformation produces transgenic events with higher transgene expression levels (particularly, it appears, in subsequent generations). Stability of expression over generations is an important issue because commercial products are typically at least 5-7 generations away from the transgenic T0. Stability of expression is obviously a large advantage for product development. Based on the literature, single-low copy number results in less transgene silencing in subsequent generations.

In view of the above comments and amendments, withdrawal of the outstanding rejections and allowance of the remaining claims is respectfully requested.

Respectfully submitted,



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